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Scott G. Newnam

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WILMERHALE/BOSTON

60 STATE STREET

BOSTON, MA 02109

EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT

PAPER NUMBER

2145

NOTIFICATION DATE

DELIVERY MODE

02/15/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|                              |  |                                      |  |
|------------------------------|--|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/804,815     | <b>Applicant(s)</b><br>NEWNAM ET AL. |  |
|                              | <b>Examiner</b><br>Jeffrey R. Swearingen | <b>Art Unit</b><br>2145              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 and 46-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 and 46-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20071123</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/2007 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 11/5/2007 have been fully considered but they are not persuasive.

3. Applicant argued Walker failed to disclose the information in Walker identifies a specific type of layout irrespective of the video program. The layout is how the information is presented, not when the information is presented. Column 7, lines 17-47 present alternate ways for information to be accessed using a web page. The web page uses conventional HTTP, which is a specific type of layout irrespective of the video program.

4. Applicant argued Walker failed to store or retrieve layout information...in the client specific to the message type identifier formatting the at least one of the downloaded interactive components in a particular layout format. Applicant admits Walker discloses web pages, which contain layout information. This is the layout information which is stored and retrieved in the client specific to the message type identifier for use to format the at least one of the downloaded interactive components in a particular layout format.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-35 and 46-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (US 6,263,505 B1).

7. In regard to claim 1, 17, 46, 49, Walker disclosed:

*receiving client software for a client to operate on a user-based hardware device that has the ability to control a display, the client software including:*

*base software for causing information to be displayed on the display and including software responsive to messages relating to different types of interactivity,*  
column 7, lines 33-47

*program content applicable to a plurality of episodes of the video program,*  
column 4, lines 55-62 and

*episode content applicable to a particular one of the plurality of episodes of the video program, wherein the program content and the episode content are downloaded to the client before the beginning of the particular episode, the episode content including interactive components for later display during the particular episode and being received by the client before the beginning of the particular episode, the interactive components being displayed during the particular episode in accordance with predetermined times or in response to messages from the server and prompting user interaction in response to the display of the interactive components; column 6, line 43 – column 7, line 17*

*during the particular episode the client receiving from the server a message associated with at least one of the downloaded interactive components related to the particular episode, the message including a message type identifier selected from a plurality of predefined message type identifiers, wherein the message type identifier identifies a specific type of layout irrespective of the video program; and column 7, lines 33-62*

*the base software receiving the message, retrieving from the message the associated message type identifier, retrieving layout information stored in the client specific to the message type identifier, and formatting the at least one of the downloaded interactive components in a particular layout format based on the retrieved layout information for causing to be displayed on the display the at least one of the downloaded interactive components in the particular layout format. Column 7, lines 48-62*

8. In regard to claim 2, 18, Walker disclosed:

*for a next episode, receiving new episode content with components related to the next episode prior to the beginning of the next episode without again receiving the program content and the base software. Column 10, lines 1-6*

9. In regard to claim 3, 19, Walker disclosed:

*for an episode of a different program, receiving a different program content and a different episode content without again receiving the base software prior to the beginning of the episode of the different program, and using the base software with the different program content and the different episode content for the episode of the different program. Column 7, lines 48-62*

10. In regard to claim 4, 20, Walker disclosed:

*the video program is a television program. Column 4, line 27*

11. In regard to claim 5, 21, Walker disclosed:

*at least two of the types of interactive components include a question to which a user can respond. Column 5, lines 24-35*

12. In regard to claim 6, 22, Walker disclosed:

*the interactive components include a trivial question and a poll. Column 5, lines 24-35*

13. In regard to claim 7, Walker disclosed:

*the message includes the message type identifier corresponding to trivia questions, and includes text for a particular trivia question, the base software being responsive to the message*

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*type identifier corresponding to trivia questions and formatting and displaying the text in the particular layout format corresponding to trivia questions. Column 5, lines 24-35*

14. In regard to claim 8, Walker disclosed:

*the formatting further includes displaying a point count for the particular trivia question that changes with time. Column 5, lines 24-35*

15. In regard to claim 9, 23, Walker disclosed:

*the base software, responsive to a user entering an answer, causes the answer to be provided to the server to determine if it is correct. Column 5, lines 24-35*

16. In regard to claim 10, 23, Walker disclosed:

*the base software, responsive to a user entering an answer, checks the answer against an answer stored as part of the episode content. Column 5, lines 24-35*

17. In regard to claim 11, 23, Walker disclosed:

*one of the client and the server corrects the answer, the client receiving from the server and displaying a point total for multiple users interacting at the same time with the server.*

Column 5, lines 24-35

18. In regard to claim 12, 24, Walker disclosed:

*the client is presentation layer independent. Column 9, lines 10-23*

19. In regard to claim 13, 25, Walker disclosed:

*the client operates with a particular type of presentation software. Column 9, lines 10-23*

20. In regard to claim 14, Walker disclosed:

*the client sending messages from the user to the server and receiving messages from other users via the server in a chat functionality during the particular episode of the program.*

Column 5, lines 24-35

21. In regard to claim 15, Walker disclosed:

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*the episode content includes a plurality of advertisements, the base software being responsive to messages for causing one of the advertisements to be displayed.* Column 5, lines 50-61

22. In regard to claim 16, Walker disclosed:

*the client is responsive to the receipt of the message and audio or video information for synchronizing the audio or video information to the type of interactivity indicated by the message.* Column 7, lines 48-61

23. In regard to claim 26, Walker disclosed:

*invoking a software interface for managing the server and providing messages to and receiving messages from the server.* Column 9, lines 10-23

24. In regard to claim 27, Walker disclosed:

*the server provides messages received from users to the software interface during the episode, wherein the software interface is further invoked to transmit responses to the server for forwarding to the users.* Column 9, lines 10-23

25. In regard to claim 28, Walker disclosed:

*at least some questions for responses are transmitted by the software interface to the server, and thereafter to the users on-the-fly during the particular episode.* Column 5, lines 24-61

26. In regard to claim 29, Walker disclosed:

*the program is a television program, wherein the software interface is invoked to provide the program or episode content to the server for transmission to the users, the program or episode content being stored and timed to be received by the user in such a way that the program or episode content is synchronized to the television program to display content relevant to the program at that time.* Column 5, lines 24-61

27. In regard to claim 30, Walker disclosed:

*the program or episode content is provided to be stored in advance of being displayed and is timed to appear at selected times.* Column 9, line 41 – column 10, line 6

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28. In regard to claim 31, 47, 50, Walker disclosed:

*the software interface receives supplemental content in response to a human input and provides the supplemental content on the fly as a supplement to the program or episode content provided to be stored in advance. Column 5, lines 24-35; column 9, line 41 – column 10, line 6*

29. In regard to claim 32, Walker disclosed:

*the software interface receives supplemental content in response to a human input and provides the supplemental content on the fly to appear at a desired time such that the supplemental content is relevant to the program at the desired time. Column 5, lines 24-35*

30. In regard to claim 33, Walker disclosed:

*the episode content includes a plurality of advertisements for client storage, the server sending messages to indicate to the client that the client should cause one of the stored advertisements to be displayed. Column 5, lines 50-61*

31. In regard to claim 34, Walker disclosed:

*the server provides audio or video information synchronized to textual messages to cause the textual messages to be displayed with the audio and/or video content. Column 8, lines 6-37*

32. In regard to claim 35, Walker disclosed:

*messages can be provided to thousands of users at the same time. Column 9, lines 10-23*

33. In regard to claim 48, Walker disclosed:

*prior to receipt of any of a plurality of episodes of the video program, receiving common content related to the plurality of episodes, and prior to each episode, downloading content particular to that episode. Column 10, lines 1-6*

34. In regard to claim 51, Walker disclosed:

*at least one of the interactive components is displayed based on predetermined times during the particular episode. Column 9, lines 41-59*

35. In regard to claim 52, Walker disclosed:



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*further interactive components are received and displayed on-the-fly.* Column 5, lines 24-61

36. In regard to claim 53, Walker disclosed:

*the predefined message type identifiers are selected from a group consisting of facts, trivia questions, and poll questions.* Column 5, lines 24-61

37. In regard to claim 54, Walker disclosed:

*the interactive components prompt user responses to the trivia or poll questions.* Column 5, lines 24-61

38. In regard to claim 55, Walker disclosed:

*wherein the client software is stand-alone application.* Column 10, lines 11-12

39. In regard to claim 56, Walker disclosed:

*wherein the client software is a web-browser application.* Column 10, lines 1-6

### **Conclusion**

40. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Palmer et al. US 6,577,324

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571)272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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